REMARKS

In response to the Office Action mailed December 11, 2007, Applicant respectfully requests reconsideration. To further the prosecution of this Application, Applicant submits the following remarks and has added new claims. The claims as now presented are believed to be in allowable condition.

Claims 1-23 were pending in this Application. By this Amendment, claims 24-26 have been added. Accordingly, claims 1-26 are now pending in this Application. Claims 1, 3, 7, and 18 are independent claims.

Claims 1 and 15 have been amended to correct typographical errors. No new matter has been added, and no new search is required.

Allowed Claims

Claims 18-23 have been allowed.

Claims 9-17 were objected to as being dependent on a rejected base claim but were deemed allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. Applicant reserves the right to amend claims 9-17 to include all of the limitations of the base claim and any intervening claims until Applicant receives a reply to Applicant's request for reconsideration of claims 7-8.

Drawings

The Office Action does not indicate whether the Drawings on record with the Application are acceptable or not. Applicant respectfully requests that the next communication from the Office indicate that the Drawings are accepted.

Rejections under §103

Claims 1-8 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Publication No. 2003/0037041 (Hertz, hereinafter <u>Hertz '041</u>) in view of U.S. Patent No. 6,249,772 (<u>Walker, et al.</u>). Claims 1-8 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,754,939 (Herz, hereinafter <u>Herz '939</u>) in view of (<u>Walker, et al.</u>).

Applicant respectfully traverses each of these rejections and requests reconsideration. The claims are in allowable condition.

<u>Hertz '041</u> and <u>Herz '939</u> disclose a system for customized electronic identification of desirable objects in an electronic media environment. The system produces a "target profile" for each target object and a "target profile interest summary" for each user of the system. The system evaluates the target profiles against the target profile interest summaries to generate a user-customized rank ordered listing of target objects likely to be desirable by each user. (ABSTRACT).

<u>Walker</u> discloses a system and method for buying a product from at a first price and acquiring the product from a merchant that typically offers the product for sale at a second price (ABSTRACT). A customer is able to remotely lock-in a specific price for a product with the manufacturer and select a local store where the product can be picked up (Col. 4, line 65 through Col. 5, line 12). The customer is then able to go to the local store and purchase the product for the locked-in price, even though the local store normally charges a different price for the same product (Col. 5, lines 13-34).

Claims 1-2

Claim 1 recites a method of retrieving "targeted information" while protecting consumer privacy. In general, the method recites the steps of (i) providing "elements of information," (ii) specifying a negotiant function, and (iii) "distributing" the negotiant function to a consumer for "execution by the

consumer." The input to the negotiant function is elements of data associated with a consumer. The output of the negotiant function is an information request that designates, based on the input, at least one of the elements of information referred to in step (i) to present to the consumer.

The Office Action rejects claims 1-2 under 35 U.S.C. §103(a) as being unpatentable over Hertz '041 in view of Walker. Claim 1 is patentable over the combination of Hertz '041 and Walker because the combination of Hertz '041 and Walker fails to teach distributing a negotiant function to a consumer for execution by the consumer.

Claim 1 describes a negotiant function as a function that accepts elements of data associated with a consumer as input, and produces an information request as output. The specification supports this description of a negotiant function (see for example paragraphs [0032-35] of the specification).

Neither Hertz '041 nor Walker, alone or in combination, teaches a negotiant function. The Office Action cites the abstract and paragraphs [0014-15], [0018], and [0205] of Hertz '041 as teaching "distributing the negotiant function." However, the cited portions do not disclose any "negotiant" function.

In any event, neither Hertz '041 nor Walker, alone or in combination, teaches "distributing" the negotiant function to a consumer for "execution by the consumer." To address this deficiency of Hertz '041, the Office Action relies on Walker. The Office Action, on page 3, characterizes Walker as teaching "a system/method wherein a consumer negotiates a price for a selected product, the consumer is assured that he will actually receive the product (see., abstract, col 10, lines 35-45)." This teaching from Walker does not supply that which is missing from Hertz '041. It does not teach the "distributing the negotiant function to a consumer for execution by the consumer" limitation of claim 1.

Walker's system allows a user to identify and select, through a computer-based web browser, a product at a local retailer:

> In system 100, when user computer 102 identifies a
> product online via an interactive web-browser, user
> computer 102 is then provided a price established by
> a manufacturer and transmitted from central controller
> 110. Thereafter, a user/customer can purchase and
> pick up the selected product from a retailer, selected
> from the list of retailers who have agreed to honor the
> price set by the manufacturer and transmitted to user
> computer 102, regardless of the retailer's normal price
> for such product. Accordingly, system 100 allows user
> computer 102 to log onto a central controller via
> network 106 and "lock-in" a price for an item which
> may be different from the shelf price posted at the
> local store from which the customer chooses to
> subsequently purchase that item.

(Walker, col. 10, lines 10-23).

As the Examiner points out, Walker's system allows a user to establish a
price for the product through the computer-based web browser, and reserve the
selected product at the local retailer until he purchases the product:

> In addition to the notion of selecting goods and
> products and establishing prices for the same online,
> system 100 allows for local store inventory checking
> and inventory reservations so that a customer knows
> and is assured that he may acquire a particular
> product for which he received a price online.
> Accordingly, after a consumer negotiates a price for a
> selected product, the consumer is assured that he will
> actually receive the product when he goes to a
> selected retailer to acquire that product. As such,
> system 100 can allow a hold or reservation to be
> made to reserve an inventory item at a local store.

(Walker, col. 10, lines 35-45).

According to Walker, a user can "negotiate" a price for a product through a
computer-based web browser by selecting a price set by a manufacturer. The
user does not select this price by executing a negotiant function that has been
distributed to him, but rather selects the price by performing actions on his own.
In Walker, no negotiant function is distributed. In Walker, a consumer does not
execute a distributed negotiant function. Therefore the Walker reference does not

supply the limitation that is missing from Hertz '041, i.e., distributing the negotiant function to a consumer for execution by the consumer.

In addition, the Office Action rejects claims 1-2 under 35 U.S.C. §103(a) as being unpatentable over Herz '939 in view of Walker. However, Herz '939 recites similar subject matter as does Hertz '041 – indeed both Herz '939 and Hertz '041 belong to the same Application family, both claiming priority to U.S. Patent Application No. 08/346,425 (now issued as U.S. Patent No. 5,758,257). Indeed, the two rejections presented in the Office Action, on pages 3-5, over both Hertz '041 and Herz '939 in view of Walker, appear to be word-for-word identical to each other, citing corresponding paragraphs in both Hertz '041 and Herz '939 (although in the final paragraph of page 4, paragraphs are incorrectly cited in Herz '939 when that patent actually uses columns and line numbers, the cited paragraph numbers being the very ones cited in Hertz '041 on page 3 of the Office Action – this lends further support to the argument that the rejections over Hertz '041 and Herz '939 are substantively identical).

Claim 1 is patentable over the combination of Herz '939 and Walker because, as argued above in connection with the combination of Hertz '041 and Walker, the combination of Herz '939 and Walker fails to teach distributing a negotiant function to a consumer for execution by the consumer.

Furthermore, Applicant wishes to point out that the Office Action dated December 9, 2005 previously rejected claims on a virtually identical basis over U.S. Patent No. 6,460,036 (Herz, hereinafter Herz '036) in view of Walker. Herz '036 also belongs to the same Application family as do Hertz '041 and Herz '939, and indeed Hertz '041 is a divisional of Herz '036. That previous rejection was withdrawn by the Patent Office in the Office Action dated May 24, 2007. Applicants believe it is improper for the Office to withdraw a rejection in one Office Action and then re-impose an equivalent rejection in a subsequent Office Action, see, e.g., MPEP 707.07(g) ("The examiner ordinarily should reject each claim on *all valid grounds available*.").

For the reasons stated above, claim 1 patentably distinguishes over the cited prior art, and the rejections of claim 1 under 35 U.S.C. §103(a) should be withdrawn. Accordingly, claim 1 is now in allowable condition.

Because claim 2 depends from and further limits claim 1, claim 2 is in allowable condition for at least the same reasons. Additionally, it should be understood that the dependent claim recites additional features which further patentably distinguish over the cited prior art.

Claims 3-6

Claim 3 recites a method of retrieving "targeted information" while protecting consumer privacy. In general, the method recites the steps of (i) receiving a negotiant function and (ii) executing the negotiant function. Upon execution, the negotiant function generates an information request. The information request designates at least one element of information from among a plurality of elements of information.

Claim 3 is patentable over both the combination of Herz '939 and Walker and the combination of Hertz '041 and Walker because, as argued above in connection with claim 1, those combinations fail to teach receiving a negotiant function and executing the negotiant function.

For the reasons stated above, claim 3 patentably distinguishes over the cited prior art, and the rejections of claim 3 under 35 U.S.C. §103(a) should be withdrawn. Accordingly, claim 3 is now in allowable condition.

Because claims 4-6 depend from and further limit claim 3, claims 4-6 are in allowable condition for at least the same reasons. Additionally, it should be understood that the dependent claims recite additional features which further patentably distinguish over the cited prior art.

Claims 7-8

Claim 7 recites a method of retrieving "targeted information" while protecting consumer privacy. In general, the method recites the steps of (i) distributing a negotiant function to consumers and (ii) receiving information requests associated with the consumers. As described above for claim 1, inputs to the negotiant function are elements of data associated with a consumer, and outputs of the negotiant function are information requests. Claim 7 recites generating each information request associated with a consumer by applying the negotiant function to data associated with the consumer.

Claim 7 is patentable over both the combination of Herz '939 and Walker and the combination of Hertz '041 and Walker because, as argued above in connection with claim 1, those combinations fail to teach receiving a negotiant function and executing the negotiant function.

For the reasons stated above, claim 7 patentably distinguishes over the cited prior art, and the rejections of claim 7 under 35 U.S.C. §103(a) should be withdrawn. Accordingly, claim 7 is now in allowable condition.

Because claim 8 depends from and further limits claim 7, claim 8 is in allowable condition for at least the same reasons. Additionally, it should be understood that the dependent claim recites additional features which further patentably distinguish over the cited prior art.

Newly Added Claims

Claims 24-26 have been added and are believed to be in allowable condition. Claim 24 depends from claim 1. Claim 25 depends from claim 4. Claim 26 depends from claim 7. Support for claims 24-26 is provided within the Specification, for example, in paragraphs 0031-0033. No new matter has been added.

<u>Conclusion</u>

In view of the foregoing remarks, this Application should be in condition for allowance. A Notice to this affect is respectfully requested. If the Examiner believes, after this Amendment, that the Application is not in condition for allowance, the Examiner is respectfully requested to call the Applicant's Representative at the number below.

Applicant hereby petitions for any extension of time which is required to maintain the pendency of this case. If there is a fee occasioned by this Amendment, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. <u>50-3661</u>.

If the enclosed papers or fees are considered incomplete, the Patent Office is respectfully requested to contact the undersigned collect at (508) 616-2900, in Westborough, Massachusetts.

Respectfully submitted,

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